

**Advisory Action
Before the Filing of an Appeal Brief**

Application No. 10/518,315	Applicant(s) FALK ET AL.
Examiner JYOTI CHAWLA	Art Unit 1794

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 06 March 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.
NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____.
Claim(s) objected to: _____.
Claim(s) rejected: 1-26.
Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:
See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s) _____.
13. ☒ Other: See Continuation Sheet

/JENNIFER MCNEIL/
Supervisory Patent Examiner, Art Unit 1794

/JCI/

Continuation of 11. does NOT place the application in condition for allowance because: Applicant's arguments filed 3/6/2009 have been fully considered but they are not persuasive.

I) Applicants' argument that Bohm does not teach the pH of silica sol with acidic pH as recited (Remarks, page 8, last paragraph, and page 9, first paragraph). In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Bohm has been applied in an obviousness rejection in view of Tanaka (US 5622743). In the instant case, Bohm teaches a method for fining, clarifying and stabilizing liquid foods comprising adding to the liquid foods colloidal, anionic silica sols having particle diameter of 2-200 millimicron (nm) (Column 1, lines 37-47 and claim 4) which includes applicants recited range of 4-150 nm. Regarding surface area Bohm teaches of silica sol particles of 50-600 m²/g (Column 4, lines 22-28), which falls in applicant's recited range of 20 to 700 m²/g. Also see (Abstract, Column 2, lines 40-45, Column 4, lines 22-28). Regarding the pH of silica sol, Bohm teaches that both acidic and alkaline sols were available at the time, however, Bohm does not specify the pH of silica sol used to fine or clarify or stabilize liquid foods. Tanaka teaches of treatment of beer (liquid food) to stabilize beer with aqueous silica suspension having a pH range of 3.5 to 5 (Abstract, column 4, lines 15-25), which includes pH values in applicant's recited range of pH 1-4. Tanaka also teaches that aqueous silica suspension that is acidic is preferred because it falls in a pH region like that of beer and is more effective in removing turbidity precursors without deteriorating the froth-holding property of beer (Column 2, lines 45-55). Thus, aqueous suspensions of silica in acidic range were known to be used to clarify or stabilize beer or liquid foods at the time of the invention (Tanaka). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Bohm and use acidic aqueous silica suspension with pH in the range as taught by Tanaka to clarify food liquids, like beer, in order to effectively remove turbidity precursors without deteriorating the froth-holding property of beer, as taught by Tanaka.

II) Regarding applicants' allegation that Bohm teaches away from the claimed invention as Bohm does not specifically state "the desirability of using weakly acidic commercially available silica sols". Applicants seem to have arrived at this conclusion based on applicant's exemplary statement that "process of producing silica sols modified with aluminum compounds are already known. One method for producing sols of this kind is described, for example, in US patent 2892797." Thus, applicants conclude that all alumina treated silica sols were alkaline in pH and that Bohm teaches against applicant's invention. In response although Bohm provides an example of aluminum modified silica sols, it does not mean that Bohm in its entirety is teaching against acidic silica sol. Further, in response to applicant's argument that all aluminum treated silica sols were alkaline in nature, the office provides Mindick et al (US 3252917) as an example that not all aluminum treated silica sols had alkaline pH. Mindick et al teach aluminum treated silica sols with acidic pH (See Column 3, Column 4, lines 25-35 and Column 5, lines 60-70 and Column 7, lines 65-70). Thus, it is noted that aluminum treated silica sols were known at the time of Bohm and Bohm teaches of aluminum treated silica sols in general and therefore does not teach against acidic silica sols and also does not teach against the instantly claimed invention. Bohm teaches that both acidic and alkaline silica sols were known at the time of the invention and were utilized for the purpose of clarifying beverages and is therefore, relevant prior art. Further, in response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

III) Applicants' argument that "There is absolutely no teaching, suggestion or motivation in Bohm to show the desirability of using a weakly acidic commercially available silica sol" has been considered. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., weakly acidic commercially available silica sol) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thus applicant's arguments have been fully considered and have not been found persuasive, and the rejections are maintained for the reasons of record.

Continuation of 13. Other: Attached is an initialed copy of IDS of 1/26/09 submitted by the applicant and Form 892 including the Mindick reference.